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REMARKS

Claims 1 – 36 are pending in the present Application. Claims 30 – 36 have been withdrawn from consideration, Claims 18 – 35 have been cancelled, Claims 1, 2, 6, and 9, have been amended, and Claims 37 – 42 have been added, leaving Claims _____ for consideration upon entry of the present Amendment. The Specification has been amended to correct certain typographical errors, as explained in detail below.

Claim 1 has been amended to add “and” in the description of the solvent.

Claim 2 has been amended to correct its dependency.

Claim 6 has been amended to insert “that” before “changes”.

Claim 9 has been amended to correct a spelling error.

New Claims 37 – 42 have been added to further claim the present invention. Support for these amendments can be found in the claims as originally filed.

These amendments were merely for clarity and do not narrow the claims and were not made to overcome prior art.

No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Objections

Claims 6 and 9 have been objected to due to minor formalities. Claim 6 has been amended to insert “that” before “changes”, while Claim 9 has been amended to correct the spelling of butyrolactone. Reconsideration and withdrawal of this objection are respectfully requested.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claim 2 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 has been amended to correct the dependency thereof. Reconsideration and withdrawal of this rejection are respectfully requested.

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Claim Rejections Under 35 U.S.C. § 102(b)

Claims 18 and 21 – 29 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 5,006,370 to Eisenbraun et al. Claims 18 – 29 have been cancelled, thereby rendering this rejection moot.

Claims 1, 7 – 11, and 14 – 17 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 5,916,632 to Mishina et al. Applicants respectfully traverse this rejection.

Mishina et al. teach a polyimide varnish. The polyimide varnish...is a varnish having the [] polyimide and/or a polyimide precursor dissolved in an organic solvent, and from 5 wt% to 60 wt%... of the organic solvent constituting this varnish **must** be a propylene glycol derivative..." (Col. 3, lines 48 – 53; **emphasis added**) Mishina et al. fail to teach, suggest, or mention that the solvent is, can, or should have "a boiling point at atmospheric pressure of about 110°C to about 250°C, a polarity index of greater than or equal to about 4.0, and a pH of about 5.5 to about 9", as is taught and claimed in the present application.

The rejection relies upon the disclosure in Mishina et al. of using "N-methylpyrrolidone, N,N-dimethylacetamide, N,N- dimethylformamide, dimethylsulfoxide, hexamethylphosphoramide or γ - butyrolactone" as a solvent. (Col. 4, lines 10 – 13). However, the entire teaching is as follows:

Of the entire solvent constituting the polyimide varnish of the present invention, *the solvent other than the above-described propylene glycol derivative* is not particularly limited so long as it is capable of dissolving the polyimide and/or the polyimide precursor. For example, it may be 2-pyrrolidone, N-methylpyrrolidone, N,N-dimethylacetamide, N,N- dimethylformamide, dimethylsulfoxide, hexamethylphosphoramide or γ - butyrolactone.

(Col. 4, lines 6 – 13; **emphasis added**) In other words, although the solvents cited in the office action can be employed, they **must** be employed, if at all, with the propylene glycol derivative. There is no teaching, suggestion, or reason to believe that the solvent of Mishina et al. meets the elements of the present Claim 1. If the solvents cited in the office action are employed, they are only employed in a combination with the propylene glycol.

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The present application teaches and claims a spin coating process using a solution solvent, "wherein the solution solvent has a boiling point at atmospheric pressure of about 110°C to about 250°C, a polarity index of greater than or equal to about 4.0, and a pH of about 5.5 to about 9". (Claim 1)

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

Mishina et al. fail to teach several elements of Claim 1, including the elements of the solution solvent. For at least this reason, Mishina et al. fail to anticipate the present Claim 1, as well as the claims depending therefrom. It is noted that, since the coating composition of Mishina et al. is different than the solution of the present application, the claimed properties, are not inherent and also clearly not anticipated. For example, Mishina et al. fail to teach the solvent of the present application, and hence, there is no teaching or suggestion that the "solvents of Mishina et al. must necessarily have the claimed dielectric constant..." or that "the coating of Mishina et al. must necessarily have the claimed peel strength and haze level." (Office Action, page 5) Reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Eisenbraun et al. in view of U.S. Patent No. 5,094,884 to Hillman et al. Claims 19 and 20 have been cancelled, thereby rendering this rejection moot.

Claims 2 – 6 and 12 – 13 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Mishina et al. as discussed above. Applicants respectfully traverse this rejection.

Mishina et al. are relied upon in the Office Action with the remainder of the elements merely identified as optimizations, cause effective variables, etc.

It is first noted that Claims 2 – 6, 12, and 13 all depend from Claim 1, which, as discussed in detail above, is different than Mishina et al., hence, by definition, these dependent claims are allowable.

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Applicants have identified a solution solvent and process to form plastic coated substrates meeting stringent surface quality requirements.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

In order for Mishina et al. to render the present invention obvious, there would have to be a teaching or motivation to use a solvent meeting the elements set forth in the present application. There is no teaching, suggestion, or reason to believe that the solvent of Mishina et al. would meet the limitations. There is also no teaching or motivation to use a thermoplastic polymer having the molecular weight (that is, the particular thermoplastic polymer), T_g, and/or viscosity claimed in the present application. Additionally, there is no teaching, suggestion, or motivation for employing a thermoplastic polymer that has a weight average molecular weight that changes by less than or equal to about 10% during the entire process.

For at least these reasons, the claimed process of the present invention is non-obvious over Mishina et al. Additionally, not only are the dependent claims patentable as depending from an allowable independent claim, these claims also add patentable subject matter that is non-obvious in view of the art of record. Reconsideration and withdrawal of this rejection are respectfully requested.

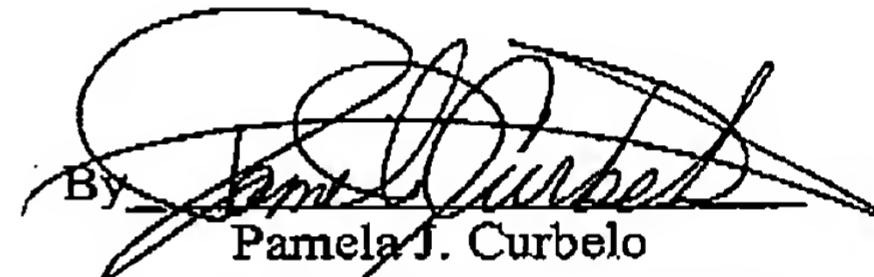
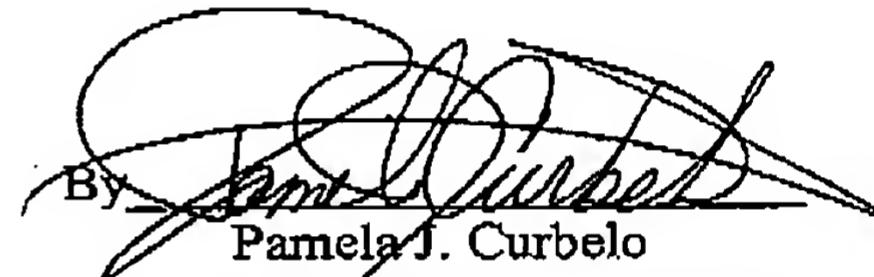
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It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the objection and rejections and allowance of the case are respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862.

Respectfully submitted,

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